

ESTTA Tracking number: **ESTTA712237**Filing date: **12/02/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Warner Bros. Entertainment Inc.
Granted to Date of previous extension	12/02/2015
Address	4000 Warner Blvd. Burbank, CA 91522 UNITED STATES

Correspondence information	Warner Bros. Entertainment Inc. 4000 Warner Blvd. Burbank, CA 91522 UNITED STATES avis.frazier-thomas@warnerbros.com Phone:8189544956
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**Applicant Information**

Application No	86202212	Publication date	08/04/2015
Opposition Filing Date	12/02/2015	Opposition Period Ends	12/02/2015
Applicant	TREASURY WINE ESTATES AMERICAS COMPANY 610 Airpark Road Napa, CA 94558 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 033. First Use: 2004/00/00 First Use In Commerce: 2004/00/00 All goods and services in the class are opposed, namely: wines
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

**Marks Cited by Opposer as Basis for Opposition**


U.S. Registration No.	1836849	Application Date	11/19/1992
Registration Date	05/17/1994	Foreign Priority Date	NONE
Word Mark	TASMANIAN DEVIL		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 025. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 T-shirts and dorm shirts

U.S. Registration No.	1998467	Application Date	12/27/1995
Registration Date	09/03/1996	Foreign Priority Date	NONE
Word Mark	TASMANIAN DEVIL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1982/06/01 First Use In Commerce: 1982/06/01 toys, games, and sporting goods, namely action figures and accessories therefor; plush toys; balloons; bathtub toys; ride-on toys; card game equipment sold as a unit; toy vehicles; dolls; flying discs; electronic hand held game unit; game equipment sold as a unit for playing a board game, a card game, a manipulative game, a parlor game, a parlor-type computer game, an action type target game; video and computer game cartridges; video and computer game programs, cart-ridges, and cassettes; video output game machines; jigsaw, manipulative, and cube puzzles; paper face masks; costume mask; skateboards; ice skates; water squirting toys; balls, namely playground balls, soccerballs, sportballs, baseballs, basketballs; baseball gloves; swimming floats for recreational use; kickboard flotation devices for recreational use; surfboards; swim boards for recreational use; swim fins; Christmas tree ornaments		

U.S. Registration No.	1846790	Application Date	11/19/1992
Registration Date	07/26/1994	Foreign Priority Date	NONE
Word Mark	TAZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 T-shirts		

U.S. Registration No.	2130049	Application Date	09/05/1996
Registration Date	01/20/1998	Foreign Priority Date	NONE
Word Mark	TAZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1988/08/01 First Use In Commerce: 1988/08/01 clothing for men, women, and children, namely, sweatshirts, [ jogging suits, trousers, ] jeans, shorts, [ tank tops, rainwear, cloth bibs, skirts, blouses, dresses, suspenders, sweaters, ] jackets, [coats, raincoats, snow suits, ties, robes, ] hats, caps, [ sunvisors, belts, scarves, ] sleepwear, pajamas, [ lingerie,] underwear, boots, shoes, sneakers, sandals, [ booties, ] slipper socks, [ swimwear, ] and masquerade and Halloween costumes and masks sold in connection		

	therewith		
U.S. Registration No.	3168693	Application Date	01/10/2006
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	TAZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1995/01/17 First Use In Commerce: 1995/01/17 Toys and sporting goods, including games and playthings--namely, [ action figures and accessories therefor; plush toys; balloons; bathtub toys; ride-on toys; equipment sold as a unit for playing card games; toy vehicles; dolls; flying discs; electronic hand-held game unit; game equipment sold as a unit for playing a board game, a card game, a manipulative game, a parlor game and an action type target game; jigsaw and manipulative puzzles; paper face masks; skateboards; ice skates; water squirting toys; ] balls--namely, playground balls, [ soccer balls, baseballs, ] basketballs, [ bowling balls; baseball gloves; swimming floats for recreational use; kickboard flotation devices for recreational use; surfboards; swim boards for recreational use; swim fins; toy bakeware and toy cookware; toy banks; ] toy snow globes; and Christmas tree ornaments		

Attachments	78788901#TMSN.png( bytes ) TAZ.TasmanianDevil.pdf(72389 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/AVIS FRAZIER-THOMAS/
Name	Warner Bros. Entertainment Inc.
Date	12/02/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Opposition No. 86/202,212 for the mark TAZ filed February 24, 2014 and published August 4, 2015

WARNER BROS. ENTERTAINMENT INC.

Opposer

v.

Opp. No. \_\_\_\_\_

TREASURY WINE ESTATES AMERICAS COMPANY CORPORATION

Applicant

**NOTICE OF OPPOSITION**

Opposer Warner Bros. Entertainment Inc. believes it will be damaged by the issuance of a registration for the above referenced mark and hereby opposes the referenced application pursuant to Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063 Section 14 of the Trademark Act of 1946, 15 U.S.C. §1064. As grounds for the opposition Opposer alleges that:

1. Opposer is the owner of all rights, title and interest in and to a family of marks that include the words TAZ (sometimes referred to as TASMANIAN DEVIL) and various distinctive cartoon character design marks ("Opposer's TAZ Marks"),

2. Opposer's TAZ Marks have been used extensively on a wide variety of goods and services including, among other things, food and beverage products, cups and glasses, bottles, cup holders, DVDs and videos, entertainment services, clothing, toys and games, wrist watches, jewelry, flash drives, cell phone cases, pens and pencils, sporting goods, and automotive products,

3. The TAZ Mark and other LOONEY TUNES marks have been used on many occasions in connection with goods and services directed to children or minors, including food and beverage products or services such as the HAPPY MEALS food and drinks offered to children by McDonalds which operates the world's largest network of franchised restaurants. See for example,

<http://www.youtube.com/watch?v=QOvz5mMNUWo> and

[http://www.ebay.com/itm/Looney-Tunes-Mcdonalds-TASMANIAN-DEVIL-Taz-Flash-MIP-/171067356132#ht\\_2926wt\\_904](http://www.ebay.com/itm/Looney-Tunes-Mcdonalds-TASMANIAN-DEVIL-Taz-Flash-MIP-/171067356132#ht_2926wt_904)

4. Some of the motion pictures in which the TASMANIAN DEVIL marks have been displayed have led to licensing opportunities in the food and beverage field,

[http://www.ebay.com/itm/1996-Space-Jam-Looney-Tunes-McDonalds-Happy-Meal-Toy-Complete-Set-Loose-/130913138286#ht\\_811wt\\_1018](http://www.ebay.com/itm/1996-Space-Jam-Looney-Tunes-McDonalds-Happy-Meal-Toy-Complete-Set-Loose-/130913138286#ht_811wt_1018) .

5. For more than 60 years Opposer has invested substantial sums in advertising and promoting its TASMANIAN DEVIL Marks and in insuring that the marks are suitable for use on wholesome, child friendly products.

6. As a result of Opposer's successful efforts to enhance the fame and goodwill symbolized by its TASMANIAN DEVIL Marks, numerous companies have sought and obtained licenses to use those marks.

7. The Patent and Trademark Office has recognized Opposer's exclusive right to use its TASMANIAN DEVIL Marks by issuing several registrations, including the following.

- Registration No. 1,836,849, TASMANIAN DEVIL in Class 25, issued on May 17, 1994
- Registration No. 1,998,467, TASMANIAN DEVIL in Class 28, issued on September 3, 1996

- Registration No. 1,846,790, TAZ in Class 25, issued on July 26, 1994
- Registration No. 2,130,049, TAZ in Class 25, issued on January 20, 1998
- Registration No. 3,168,693, TAZ in Class 28, issued on November 7, 2006

8. These registrations for the TAZ and TASMANIAN DEVIL Marks are valid and subsisting, and some are incontestable. Accordingly, they provide prima facie and conclusive evidence of Opposer's ownership of the TAZ and TASMANIAN DEVIL Marks, and of its exclusive right to use the marks in commerce.

9. Since long prior to any first use date that Applicant may claim, Opposer's TAZ and TASMANIAN DEVIL Marks have been widely publicized and have become well-known and famous symbols of Opposer's valuable goodwill.

10. Because of the strength and fame of Opposer's TAZ and TASMANIAN DEVIL Marks they have become indelibly linked in the minds of the public with Opposer.

11. Opposer's TAZ and TASMANIAN DEVIL Marks have been used extensively with the TASMANIAN DEVIL design marks, which were first used in connection with animated productions in the early 1950s.

12. Since at least the 1950s, the fame of the TAZ and TASMANIAN DEVIL Marks has been enhanced significantly through continuous use in connection with highly popular animated productions and motion pictures, including movies that have featured such well known celebrities as Michael Jordan.

**LIKELIHOOD OF CONFUSION- §2(d)**

13. The mark that Applicant seeks to register is identical to or so resembles Opposer's Mark that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's Mark.

14. Applicant's goods are so closely related to the goods and services of Opposer that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer, or that Applicant has been licensed to use the mark TAZ by Opposer, or that Applicant is in some way connected with, sponsored by, or affiliated with Opposer.

15. Likelihood of confusion is enhanced by the fact that the parties' marks are identical.

16. Likelihood of confusion is enhanced by the fact that the parties' goods and services are closely related.

17. Likelihood of confusion is enhanced by the fact that consumers are likely to believe that Applicant is using its alleged mark pursuant to a license from Opposer.

18. Applicant has never sought any license to use Opposer's marks TAZ and TASMANIAN DEVIL.

19. Likelihood of confusion may be presumed in light of the fact that Applicant obviously adopted an imitation of Opposer's Mark with prior knowledge of Opposer's Mark and with an intent to cause confusion and to capitalize on the popularity of Opposer's Mark.

20. Applicant is not affiliated or connected with or endorsed or sponsored by Opposer, nor has Opposer approved any of the goods offered or sold by Applicant under the mark TAZ nor has Opposer granted Applicant permission to use said mark.

DECEPTION/ FALSE SUGGESTION OF CONNECTION- §2(a)

21. Applicant's mark so closely resembles Opposer's Mark that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the services, purchasers are likely to believe that the misdescription actually describes the nature or origin of the services, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods or services.

22. Applicant's alleged mark so closely resembles Opposer's Mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that services sold under Applicant's alleged mark are connected with Opposer.

23. When Applicant's alleged mark is used on goods of the type described in its application, Applicant's alleged mark will cause purchasers to buy Applicant's goods or services based on the mistaken assumption that Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's services by permitting Applicant to use said mark.

24. Applicant's alleged mark is deceptive in that it falsely suggests a connection with, or approval by Opposer.

25. Use and registration by Applicant of the mark TAZ will deprive Opposer of the ability to protect its reputation, persona and goodwill.



26. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's alleged mark and registration should be refused.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

WARNER BROS. ENTERTAINMENT, INC.

30. The goods of Applicant are so closely related to the goods of Opposer that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer or that Applicant has been licensed or otherwise authorized to use the mark TASMANIAN DEVIL by Opposer, or that Applicant is in some way connected with or sponsored by or affiliated with Opposer.

31. Likelihood of confusion is enhanced in this case by the fame of Opposer's TASMANIAN DEVIL Marks and by the fact that consumers associate them with goods and services sold, approved or endorsed by Opposer.

32. Likelihood of confusion is enhanced by the fact that Applicant's goods are closely related in nature to those sold by Opposer.

33. Likelihood of confusion is further enhanced because the marks are identical and Applicant is using another of Opposer's marks, TAZ, to deceive customers into believing that Opposer has approved Applicant's goods and services.

**DECEPTION/ FALSE SUGGESTION OF CONNECTION- §2(a)**

34. As a separate ground for Opposition, Opposer alleges that Applicant's alleged mark is deceptive or that it falsely suggests a connection with Opposer in violation of 'Section 2(a) of the Trademark Act.

35. Applicant's alleged mark is identical to Opposer's TASMANIAN DEVIL Marks and, therefore, it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the goods, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods.

36. Applicant's alleged mark so closely resembles Opposer's TASMANIAN DEVIL Marks that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that goods sold under Applicant's alleged mark are connected with Opposer.

37. When Applicant's alleged mark is used on goods of the type described in its registration, Applicant's alleged mark will cause purchasers to mistakenly assume that Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's goods by permitting the mark TASMANIAN DEVIL to be used on such goods.

38. Applicant's mark is deceptive in that it falsely suggests a connection with, or approval by, Opposer.

39. Applicant has never sought nor obtained a license from Opposer and registration of TASMANIAN DEVIL by Applicant will deprive Opposer of the ability to protect its reputation, persona and goodwill.

40. Likelihood of damage to Opposer's goodwill is enhanced by the fact that use of Applicant's mark poses a risk of injury to children who are more easily confused and prospective customers who are offended by use of a child-friendly mark like TASMANIAN DEVIL on alcoholic beverages or who encounter defects in the quality of Applicant's goods will transfer those offended feelings or attribute those defects to Opposer and this will irreparably injure Opposer and its reputation and goodwill.

### **DILUTION- §43(d)**

41. As a separate ground for opposition, Opposer alleges that Applicant's alleged mark is likely to dilute Opposer's famous TASMANIAN DEVIL Marks through dilution or tarnishment.

42. For many years, Opposer's TASMANIAN DEVIL Marks have been widely used and extensively advertised in the United States and, therefore, these names and marks have become well known and famous as distinctive symbols of Opposer's goodwill.

43. Opposer's TASMANIAN DEVIL Marks became well known and famous before long before Applicant made any use of its alleged mark and long before Applicant applied to register its alleged mark.

44. The mark shown in Applicant's application will cause dilution of the distinctive quality of Opposer's TASMANIAN DEVIL Marks.

45. Use or registration of Applicant's alleged mark will blur Opposer's famous TASMANIAN DEVIL Marks or lessen the capacity of these marks to identify and distinguish Opposer's goods and services.

46. Use and registration of Applicant's alleged mark will deprive Opposer of the ability to protect its reputation, persona and goodwill.

47. Applicant's use or registration of its alleged mark for the goods listed in its registration will tarnish the goodwill symbolized by Opposer's TASMANIAN DEVIL Marks.

48. The likelihood oftarnishment resulting from the use or registration of TASMANIAN DEVIL on an alcoholic beverage because such use poses a serious risk to

children who may be old enough to recognize the word TASMANIAN DEVIL but too young to understand the difference in the beverages bearing the mark.

49. Likelihood oftarnishment is enhanced by the fact that Applicant has a callous disregard for the potential harm that the use of its mark may cause to children in that Applicant has selected a mark that has an appeal to minors in the hope of inducing such underage individuals to consume its products in violation of law.